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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,729

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Geoffrey William Bennett

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EXAMINER

STRODER, CARRIE A

ART UNIT

PAPER NUMBER

3689

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,729	<b>Applicant(s)</b> BENNETT ET AL.	
	<b>Examiner</b> CARRIE A. STRODER	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>27 October 2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on 28 December 2004, wherein:

Claims 19-46 are currently pending; and

Claims 1-18 are cancelled.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) was submitted on 27 October 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Fig. 7 is partially illegible due shading. In addition, there are stray markings throughout the drawings. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Further, in accordance with PCT Rule 11.1, the drawings shall not contain text matter, except a single word or words, when absolutely indispensable. Applicant's drawings contain

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several pages of text in the form of an appendix (figures 8 thru 17-2). Correction is required. SEE MPEP 1825.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 19-46 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) involve a particular machine, or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 19-46, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Claims 19-30 and 43-46 state "storing in computer memory data"; however, this is a nominal recitation and therefore, is given little weight.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 19-46 are rejected** under 35 U.S.C. 102(e) as being anticipated by Or et al. (US 20020178047).

**Referring to claim 19:**

Or teaches

storing in computer memory data representing one or more facilities operated by the organization (paragraph 7 and Fig. 1; "saving information regarding recording energy usage at the facility" and "customer profile database");

storing in computer memory data representing one or more utility sources, each facility using one or more of the utility sources (paragraph 7; "saving information regarding recording energy usage at the facility");

calculating the utility consumption from each utility source for at least one facility (paragraph 7; "monitoring energy usage");

comparing the utility consumption of one or more of the facilities with the utility consumption of respective benchmark standards generated from similar facilities (paragraph 7; "comparing historical base-line usage to current energy usage"); and

generating a report detailing utility usage of one or more of the facilities, or part thereof, of the organization (Fig. 6-7).

**Referring to claim 20:**

Claim 20 is dependent on claim 19; therefore, the rejection of claim 19 is incorporated as if fully recited herein.

Or teaches

storing in computer memory data representing one or more sites operated by the organization that are associated with one or more facilities (paragraph 16; "monitors and analyzes energy consumption by collecting information...at the site of a business facility");

calculating the utility consumption from each utility source for at least one site (paragraph 16; ""monitors and analyzes energy consumption"); and

generating a report detailing the utility usage of one or more of the sites (Fig. 6-7).

**Referring to claim 21:**

Claim 21 is dependent on claim 19; therefore, the rejection of claim 19 is incorporated as if fully recited herein.

Or teaches generating a report detailing the difference between utility consumption of one or more of the facilities and their respective benchmark standards (paragraph 16 and Fig. 6-7).

**Referring to claim 22:**

Claim 22 is dependent on claim 19; therefore, the rejection of claim 19 is incorporated as if fully recited herein.

Or teaches

storing in computer memory data representing one or more mobile assets associated with the organization (paragraphs 16-17; where "equipment" is interpreted to include mobile assets);

calculating the utility consumption from each utility source for at least one mobile asset (paragraphs 16-17; "monitors and analyzes energy consumption); and

generating a report detailing the utility usage of one or more of the mobile assets of the organization (paragraph 16 and Fig. 6-7).

**Referring to claim 23:**

Claim 23 is dependent on claim 22; therefore, the rejection of claim 22 is incorporated as if fully recited herein.

Or teaches

storing in computer memory data representing one or more sites operated by the organization that are associated with one or more mobile assets (paragraphs 16-18; "particular energy system in a facility" where "energy system" is interpreted to include mobile assets);

calculating the utility consumption from each utility source for at least one site (paragraphs 16-17); and

generating a report detailing the utility usage of one or more of the sites (paragraphs 16-18 and Fig. 6-7).

**Referring to claim 24:**

Claim 24 is dependent on claim 22; therefore, the rejection of claim 22 is incorporated as if fully recited herein.

Or teaches

comparing the utility consumption of one or more of the mobile assets with the utility consumption of respective benchmark standards generated from similar mobile assets (paragraphs 16-18; "perform benchmark comparisons that show how the energy consumption and efficiency of a particular energy system in a facility compares to a benchmark comparable system"); and



generating a report detailing the difference between the utility consumption of one or more of the mobile assets and their respective benchmark standards (paragraphs 16-18 and Fig. 6-7).

**Referring to claim 25:**

Or teaches

storing in computer memory data representing one or more processes operated by the organization (paragraphs 16-18 and Fig. 1; "particular energy system in a facility" where "energy system" is interpreted to one or more processes and "customer profile database");

storing in computer memory data representing one or more utility sources, each process using one or more of the utility sources (paragraph 7; "saving information regarding recording energy usage at the facility");

calculating the utility consumption from each utility source for at least one process (paragraphs 16-18);

comparing the utility consumption of one or more of the processes with the utility consumption of respective benchmark standards generated from similar processes (paragraphs 16-18; "perform benchmark comparisons that show how the energy consumption and efficiency of a particular energy system in a facility compares to a benchmark comparable system"); and

generating a report detailing utility usage of one or more of the processes, or part thereof, of the organization (paragraphs 16-18 and Fig. 6-7).

**Referring to claim 26:**

Claim 26 is dependent on claim 25; therefore, the rejection of claim 25 is incorporated as if fully recited herein.

Or teaches

storing in computer memory data representing one or more sites operated by the organization that are associated with one or more processes (paragraphs 16-18; "particular energy system in a facility");

calculating the utility consumption from each utility source for at least one site (paragraphs 16-18; "perform benchmark comparisons that show how the energy consumption and efficiency of a particular energy system in a facility compares..."); and

generating a report detailing the utility usage of one or more of the sites (paragraphs 16-18 and Fig. 6-7).

**Referring to claim 27:**

Claim 27 is dependent on claim 25; therefore, the rejection of claim 25 is incorporated as if fully recited herein.

Or teaches generating a report detailing the difference between utility consumption of one or more of the processes and

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their respective benchmark standards (paragraphs 16-18 and Fig. 6-7).

**Referring to claims 28-30:**

Claims 28-30 are dependent on claim 25; therefore, the rejection of claims 25 is incorporated as if fully recited herein.

Claims 28-30 are rejected on the same basis as claims 22-24.

**Referring to claims 31-41:**

Claims 31-41 are the system claims associated with the method of claims 19-29; therefore, they are rejected on the same basis as claims 19-29.

**Referring to claim 42:**

Claim 42 is dependent on claim 40; therefore, the rejection of claim 40 is incorporated as if fully recited herein.

Or teaches

the benchmark database includes data representing the utility consumption of respective benchmark standards generated from similar mobile assets (paragraphs 16-18; "show how the energy consumption and efficiency of a particular energy system in a facility compares to a benchmark comparable system");

the utility consumption comparer is configured to compare the utility consumption of one or more of the mobile assets with

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the respective benchmark standards stored in the benchmark database (paragraphs 16-18; "perform benchmark comparisons that show how the energy consumption and efficiency of a particular energy system in a facility compares to a benchmark comparable system"); and

the report generator is configured to generate a report detailing the difference between a utility consumption of one or more of the mobile assets and their respective benchmark standards (paragraphs 16-18 and Fig. 6-7).

**Referring to claims 43-44:**

Claims 43-44 are the computer-readable medium claims associated with the method of claims 19 and 25; therefore, they are rejected on the same basis as claims 19 and 25.

**Referring to claim 45:**

Or teaches

means for storing in computer memory data representing one or more facilities operated by the organization (paragraph 7 and Fig. 1; "saving information regarding recording energy usage at the facility" and "customer profile database");

means for storing in computer memory data representing one or more utility sources, each facility using one or more of the utility sources (paragraph 7; "saving information regarding recording energy usage at the facility");

means for calculating the utility consumption from each utility source for at least one facility (paragraph 7; "monitoring energy usage");

means for comparing the utility consumption of one or more of the facilities with the utility consumption of respective benchmark standards generated from similar facilities (paragraph 7; "comparing historical base-line usage to current energy usage"); and

means for generating a report detailing utility usage of one or more of the facilities, or part thereof, of the organization (Fig. 6-7).

**Referring to claim 46:**

Or teaches

means for storing in computer memory data representing one or more processes operated by the organization (paragraphs 16-18 and Fig. 1; "particular energy system in a facility" where "energy system" is interpreted to one or more processes and "customer profile database");

means for storing in computer memory data representing one or more utility sources, each process using one or more of the utility sources (paragraph 7; "saving information regarding recording energy usage at the facility");

means for calculating the utility consumption from each utility source for at least one process (paragraphs 16-18);

means for comparing the utility consumption of one or more of the processes with the utility consumption of respective benchmark standards generated from similar processes (paragraphs 16-18; "perform benchmark comparisons that show how the energy consumption and efficiency of a particular energy system in a facility compares to a benchmark comparable system"); and

means for generating a report detailing utility usage of one or more of the processes, or part thereof, of the organization (paragraphs 16-18 and Fig. 6-7).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Barrett et al. (US 5216623); and
- b. Budike (US 6311105).

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/  
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
3/12/09

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